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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,570	08/14/2000	Roger William Gutwein	7721M	9947
27752	7590	09/08/2004	EXAMINER	
THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL TECHNICAL CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224			WEIER, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/638,570	Applicant(s) GUTWEIN ET AL.	
	Examiner Anthony Weier	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 6 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, and 9-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 5, 6, and 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, said claims are drawn to both an apparatus and the method steps of using the apparatus. Such claims are considered to be directed to neither a process nor a machine, but instead overlap two different statutory classes of invention within a single claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 5, 6, and 9-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, said claims are directed to an apparatus and the method steps of using same wherein it is not clear whether the claims are intended as apparatus claims or method claims, and if considered apparatus claims same are not directed to limitations regarding the structure of same. In *Ex parte Lyell*, 17 USPQ2d 1548.

In addition, it is not clear in claim 1 what time range is intended. In other words, it appears that the claim has a time range of 5-30 minutes to a maximum of 48 hours.

Written in this manner, the claim has several different overlapping ranges (5 minutes - 48 hours, 30 minutes - 48 hours, 5 minutes – 30 minutes, etc.). As such, it is not clear as to the scope of the claim with respect to the time range intended.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5, 6, and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stover (U.S. Patent No. 4,579,048).

Stover discloses a system for preparing a customized brewed coffee beverage comprising structure allowing for delaying dilution of an extract (coffee, tea, etc.) for a time (e.g. 8 minutes; see coffee reference at col. 1, lines 16-19).

The following should be noted with regard to the particular brew solids content of the extract used. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault , 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young , 25 USPQ 69 (CCPA 1935) (as restated in In re Otto , 136 USPQ 458, 459 (CCPA 1963).

6. Claims 1 and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Adler.

Adler discloses a vending machine which provides a choice of drinks to be chosen by the consumer including coffee, coffee with cream, coffee with sugar, etc (col. 2, lines 45-52). The vending machine of Adler houses is disclosed to hold coffee in the form of a concentrate (Applicants own specification describes the extract used as a "concentrate" , page 11, second paragraph) wherein said concentrate is diluted the hot water when a coin is inserted into the machine and a choice of coffee beverage is made. Adler's invention is concerned with preserving the liquid coffee and other ingredients of the vending machine by using vacuum storage and wherein "materials may be kept in the machine over extended periods of time" (col. 2, lines 18 and 19). Although not specifying a particular time, it is considered inherent that "extended period of time" would be well beyond a 5 minute (or even 30 minute) interval of storage and that the apparatus of Adler would be able to perform in such manner.

The following should be noted with regard to the use of a brew extract, specifically, and the particular brew solids content of the extract used. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault , 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re

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Young , 25 USPQ 69 (CCPA 1935) (as restated in In re Otto , 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al.

If it is shown that by “extended time”, Adler et al is referring to an apparatus which may only operate at a time range of less than 5 minutes, it would have been obvious to one having ordinary skill in the art to have modified the apparatus of Adler et al to allow same to be able to provide that said “extended period of time” would be over 5-30 minutes of time, since 5-30 minutes or less storage would be counter-productive to Adler’s suggested money-saving apparatus which uses vacuum storage for preservation of the stored ingredients for a longer time than that employed in the prior art.

Response to Arguments

9. Applicant’s arguments filed 3/15/2004 have been fully considered but they are not persuasive.

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Applicants argue that Stover does not teach a delay in dilution beyond eight minutes and that same cannot hold tea for as long as 48 hours. It should be noted, however, that the claims call for a method of using the coffee apparatus that delays dilution between a range of 5-30 minutes and up to 48 hours after onset of brewing of the extract. Stover discloses an apparatus capable of achieving, for example, a delay of 8 minutes which falls within the claimed range. As such, Stover meets this claim limitation as it would pertain to the ability of the apparatus.

Applicants further argue that Adler does not teach a maximum period of delayed dilution of 48 hours. It should be noted, however, that the claims call for a method of using the coffee apparatus that delays dilution between a range of 5-30 minutes and up to 48 hours after onset of brewing of the extract. As discussed in the rejections above, Adler discloses an apparatus capable of storage prior to dilution of an "extended period of time" wherein "extended period of time" is considered to be well beyond a 5 minute (or even 30 minute) interval of storage. As such, Adler would be able to perform in such manner. Nevertheless, even if Alder's apparatus having dilution after an "extended period of time" was shown to be outside the claimed time range, this issue has been addressed as well in Paragraph 8 above.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier
August 26, 2004

Anthony Weier
Primary Examiner
Art Unit 1761


8/26/04